

II. Rejection Under 35 U.S.C. § 103(a)

Claims 43-62 and 64-67 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EPA 0 590 604 ("EP 604") in view of U.S. Patent No. 4,874,604 ("Sramek") and Chemical Abstract 89:117546m ("546"). The Examiner contends that a person of ordinary skill would have been motivated to add the polymer of EP 604 to the composition of Sramek to impart freeze-thaw resistance and to use the polymer of '546 as a hair setting polymer in view of its high effectiveness and water resistance. Applicant respectfully traverses this rejection for the reasons of record in the parent application and as further explained below.

The Examiner has not established a *prima facie* case of obviousness for at least the following two reasons. First, the Examiner has not provided the appropriate motivation to combine necessary for establishing a *prima facie* case. Second, Applicant contends that no reasonable expectation of success exists, particularly in view of the unpredictability of the chemical arts. EP 604 itself acknowledges such at page 5, lines 54-57, wherein it implies that additional ingredients may adversely affect the performance of its hair spray composition.

With respect to motivation, analyzing the patentability of the claims requires "casting the mind back to the time of invention to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). In this

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regard, at the time the invention was made, a person of ordinary skill would have been aware of myriads of hair setting polymers, myriads of hair spray compositions, and myriads of compositions for imparting freeze-thaw stability, and not just those disclosed in the cited references. There is no reason, therefore, that one of ordinary skill would have chosen the three references relied on by the Examiner to find the particular polymers presently claimed. Further, the Examiner has pointed to nothing in the art that directs a person of ordinary skill to specifically choose the film-forming copolymer of the '546 abstract, the composition of EP 604, and the hair spray compositions of Sramek, and combine them, rather than choose any one of the other myriads of hair setting polymer, myriads of hair spray compositions, and myriads of other compositions for imparting freeze-thaw stability, and combine those.

In other words, even if a person of ordinary skill were motivated to combine a freeze-thaw composition with a hair spray composition and add a film-forming copolymer from another hair spray composition, that person would be just as likely to combine a freeze-thaw component other than those of EP 604 with a hair spray composition other than those of Sramek and a film-forming copolymer other than that of 546. There is simply no motivation in the art to focus on the particular references selected by the Examiner and thereby to make the particular combination suggested by the Examiner. Only improper hindsight, based on the Applicant's specification and claims, could have provided such incentive to combine.

In addition, even if, *arguendo*, the Examiner had established a *prima facie* case, an invention is still patentable in the face of a *prima facie* case of obviousness if there is objective indicia of non-obviousness sufficient to rebut the *prima facie* case. Applicant respectfully contends that such objective indicia of non-obviousness has been produced, specifically evidence of superior results, but that such evidence has not been properly considered by the Examiner.

It is well-settled that superior results may provide objective evidence of non-obviousness. *United States v. Adams*, 383 U.S. 39 (1966). Applicant has submitted such evidence in the specification, in the form of comparative tests, and in their Information Disclosure Statement and Supplemental Amendment, both filed July 30, 1999, in the form of testimony of competitors. As discussed in the April 17, 1998 Response in the parent application, Examples 1-3 in the specification report comparative tests which demonstrate that compositions in accordance with the invention are superior to the prior art in achieving a readily sprayable and/or vaporizable composition. As discussed in the July 30, 1999 Supplemental Amendment, Avon Techniques confirms that products within the scope of the claims provide superior results. Specifically, Avon Techniques states that its product (which falls within the scope of claims 43-67) provides "extra hold and all-over control" and that it will "spray on evenly."

For the reasons of record, set forth in Responses in the parent case and in the present Response, Applicant maintains that a *prima facie* case of obviousness has not been established by the Examiner. The Examiner has neither demonstrated that one of ordinary skill would be motivated to combine and modify the references to arrive at the claimed subject matter, nor has the Examiner demonstrated that there would be a reasonable expectation of success of such a combination. In addition, Applicant has provided evidence of superior results sufficient to rebut any *prima facie* case of obviousness.

For at least these reasons Applicant respectfully requests withdrawal of the rejection under § 103.

### III. Conclusion

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

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